Docket No.: 20136-00328-US
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Mark L. Ernest et al.

Application No.: 10/005,862 | Confirmation No.: 2036

Filed: November 8, 2001 | Art Unit: 3623

For: AUTOMATED INFORMATION TECHNOLOGY MANAGEMENT SYSTEM | Examiner: B. Van Doren

REPLY BRIEF

MS Reply Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Answer mailed June 1, 2005, the undersigned request that the points raised in this Reply Brief be considered when considering the newly raised issues of the Examiner's Answer.

The Rejection under 35 U.S.C. § 101

The Examiner has maintained that claims 1-9 remain unpatentable under 35 U.S.C. § 101. The rational for this rejection was stated on page 13 of the Examiner's Answer as:

> Claim 1 recites the steps of collecting and reporting usage data, constructing a valuation function, correlating services and components and determining a value. **None of these steps recite or require the use of any technology to be performed (*emphasis added*)**. Since all the steps are able to be performed without the use of any technology, claim 1 is not within the technological arts.

The foregoing rational for rejecting the claim under 35 U.S.C. § 101 does not appear anywhere within the MPEP Section 2106, Patentable Subject Matter Computer Related Inventions.

Indeed, MPEP Section 2106 makes continuous reference to the State Street Bank and Trust Co. v. Signature Financial Group, Inc. 149 F3d 1368 1374, 47 USPQ2d 1596 1601-1602 (Fed. Cir. 1998), where:

> The transformation of data, representing discrete mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm formula or calculation because it produces a useful concrete and tangible result a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades, also See *AT&T*, 172F3d 1358, 50 USPQ2d 1452 (claims drawn to a long distance telephone billing process containing mathematical algorithms are held patentable subject matter because the process used the algorithm to produce a useful concrete tangible result without preempting other uses of the mathematical principle.

Examiner's Reliance on *In re Van Geuns*

The Examiner's Reliance on *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993) is misplaced.

The foregoing case is an interference proceeding, wherein the Court of Appeals for the Federal Circuit affirmed the lower court case, which dealt with the patentability of claims which were in an interference count. The question of patentability under 35 U.S.C. § 102 and 35 U.S.C. § 103 was he subject of the appeal. There is no discussion in the case of *any* issue under 35 U.S.C. § 101.

The only requirement for a process claim to be statutory, is that the claim require one or more acts to be performed which define a process. To be statutory, a claimed computer related process must either a) result in a physical transformation outside the computer for a which a practical application in a technological art is either disclosed in the specification or would have been know to a skilled artisan or b) be limited to a practical application within the technological arts *In re Allapat* 33F3d. 1543 31 USPQ2d 1556-57 (discussed in MPEP 2106 (IV)(B)(2)(b)(i). The present claims meet this requirement.

Rejections under 35 U.S.C. § 112 and 35 U.S.C. § 102

The undersigned relies upon the arguments in the main brief, as the Examiner's Answer does not raise any significant new issues.

Dated: 6/29/05

Respectfully submitted,

By

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